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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/391,052	09/16/1999	YUICHI NAOI	35.C13838	7999

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EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT PAPER NUMBER

2622

DATE MAILED: 11/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/391,052

Applicant(s)

NAOI, YUICHI

Examiner

Madeleine AV Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

This communication is responsive to amendment filed on September 03, 2002.

Applicant amends claims 1, 10, 15 and adds new claims 17-46.

#### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 3, 5, 6, 8, 9, 15, 17, 18, 19, 20, 22, 23, 24-26, 28-29, 31-33, 39, 41, 42, 43, 45-46 are rejected under 35 U.S.C. 102(b) as being anticipated by D'Avello (US Patent No. 5,392,023).

Concerning claims 1, 15, 19, D'Avello discloses a communication apparatus (Fig.1) capable of accommodating a plurality of lines comprising a first communication unit (101, 102) connectable with a first communication line (telephone line), capable of reducing power dissipation on standby, and capable of communication with a remote partner; a second communication unit (109) connectable with a second communication line (data & commands line or RS-232 bus) being capable of reducing power dissipation on standby, and capable of communication with a remote partner; an input unit (105) for inputting data; and detection means (104) for detecting actuating factors for the first and second communication units; a controller (103) for controlling the first and second communication units, for shifting the second

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communication unit 102 from the standby state to the operating state in response to the detection of the actuation factor for the second communication unit by the detection unit (Figs.2A-2B; col. 2, line 3 – col. 3, line 30).

Concerning claims 2, 3, 5, 6, 8, 17, 20, 22, 23, D'Avello further teaches that the detection means detects an actuation factor in response to detection of a signal from the second communication line or in response to the key input by a user through a keyboard (in case the accessory is a computer); a power source (109) and a relay (106) for turning on and off the power supply from the power source to the second communication unit, wherein the first communication unit turns on the relay (107, 108) in response to detection of the actuation factor detected by the detection means; the power source 109 is capable of switching whether or not power is supplied to the second communication unit (109), wherein the first communication unit (101 or 102) enables the power source to start the power supply to the second communication unit in response to detection of the actuation factor by the detection means (Figs.2A-2B; col. 2, line 3 – col. 3, line 30).

Concerning claim 9, D'Avello further teaches a second detection means (103) for detecting the actuation factor with respect to the first communication unit wherein the first communication unit is provided with lower power dissipation control unit operating even on standby, and the first communication unit shifts to the low power dissipation state on standby, and the low power dissipation control unit causes the first communication unit to shift to the operational state in response to the actuation signal from the second detection means (Figs.2A-2B; col. 2, line 3 – col. 3, line 30).

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Concerning claim 18, D'Avello et al discloses the communication apparatus as discussed in claims 1, 15 above. D'Avello further teaches an output means for outputting data received by the first and second communication units wherein when the first and second units are on standby, the first communication unit shifts from the standby state to the operating state to receive data in response to detection of the actuation factor for the first communication unit, and output the received data to the output means; and on the other hand, when the first and second communication units are on standby, the second communication unit shifts from the standby state to the operating state to receive data in response to detection of the actuation factor for the second communication unit, enables the first communication unit to shift from the standby state to the operating state, and the first communication unit outputs the data to the output means unit.

It is noted that the accessory is considered as an output means since it can be a computer or a facsimile machine, and the remote facsimile machine or telephone machine connected to the first communication unit is also considered as an output means.

Claims 24-26, 28-29, 31-33 are method claims corresponding to apparatus claims 1, 2, 3, 5, 6, 8, 9. Claims 24-26, 28-29, 31-33 are rejected for the same rationales set forth for claims 1, 2, 3, 5, 6, 8, 9.

Claims 39, 41, 42, 43, 45-46 are method claims corresponding to apparatus claims 15, 2, 3, 5, 6, 8, 9. Claims 39, 41, 42, 43, 45-46 are rejected for the same rationales set forth for claims 15, 2, 3, 5, 6, 8, 9.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4, 7, 10-14, 16, 21, 27, 30, 34, 35, 36-37, 38, 40, 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Avello et al (US Patent No. 5,392,023) in view of Nakamura et al (US Patent No. 5,608,546).

Concerning claims 10-14, 21, 36, 37, 44, D'Avello et al discloses the communication apparatus as discussed in claims 1, 15 above. D'Avello further teaches an output means for outputting data received by the first and second communication units wherein when the first and second units are on standby, the first communication unit shifts from the standby state to the operating state to receive data in response to detection of the actuation factor for the first communication unit, and output the received data to the output means; and on the other hand, when the first and second communication units are on standby, the second communication unit shifts from the standby state to the operating state to receive data in response to detection of the actuation factor for the second communication unit, enables the first communication unit to shift from the standby state to the operating state, and the first communication unit outputs the data to the output means unit (Figs.2A-2B; col. 2, line 3 – col. 3, line 30).

D'Avello et al fails to teach that the apparatus includes a storage means for storing data received by the second communication and a printer for outputting data. Nakamura et al discloses a data communications apparatus having a computer modem function comprising a first

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communication unit (NCU 7) and a second communication unit (RS-232 port 14), a storage (RAM 12) for storing data received from the communication units, a printer (11) for outputting data. It would have been obvious to one skilled in the art at the time the invention was made to combining the storage in Nakamura to the system in D'Avello since both of them teach a communication apparatus capable of accommodating a plurality to lines and having standby mode in both communication units.

Concerning claims 4, 16, 27, 40, D'Avello fails to teach that the system comprises a document sheet reading unit wherein the detection means detects an actuation factor in response to detection of a document sheet in the document sheet reading unit. Nakamura et al teaches a facsimile machine (FAX1) connecting to a telephone line and to a computer through a RS-232C port (Figs. 2-4) including a reading unit 2. It would have been obvious to one skilled in the art at the time the invention was made to combine the teaching of reading unit 2 in the FAX1 of Nakamura et al to the apparatus in D'Avello due to the fact that it is operated as a facsimile machine since it comprises a transceiver (101) for transmitting and receiving data signals, modulation/demodulation (102) to modulate the data signals from the apparatus 109 for transmission and demodulate data signals after reception.

Concerning claims 7, 30, D'Avello fails to teach that the second communication unit suspends supplying a clock signal to the second communication itself on standby and starts supplying the clock signal to the second communication unit itself in response to the actuation signal from the first communication unit. Nakamura further teaches that the FAX1 includes a timer which starts to supply clock signal in response to an actuation signal from the system (col. 8, lines 31-50). It would have been obvious to one skilled in the art at the time the invention

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was made to combine the teaching of the timer in Nakamura to the system in D'Avello since D'Avello teaches that the modem or radiotelephone automatically is powered down a predetermined time after the call has entered that shows the presence of a timer (col. 15-30).

Concerning claims 11-14, 36, D'Avello further teaches that the detection means detects an actuation factor in response to detection of a signal from the second communication line or in response to the key input by a user through a keyboard (in case the accessory is a computer); a power source (109) and a relay (106) for turning on and off the power supply from the power source to the second communication unit, wherein the first communication unit turns on the relay (107, 108) in response to detection of the actuation factor detected by the detection means; the power source 109 is capable of switching whether or not power is supplied to the second communication unit (109), wherein the first communication unit (101 or 102) enables the power source to start the power supply to the second communication unit in response to detection of the actuation factor by the detection means. D'Avello further teaches that the second communication unit sends out the actuation signal to the accessory after the completion of data reception; the second communication unit transfers the data from the accessory and the first communication unit outputs the data (Figs.2A-2B; col. 2, line 3 – col. 3, line 30).

Claims 34, 35, 38 are method claims corresponding to apparatus claims 10-14 above.

Therefore, claims 34, 35, 38 are rejected for the same rationales set forth for claims 10-14.



*Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Koshiishi (US Patent No. 5,255,312) teaches a facsimile machine connectable to various communication equipments.

6. Applicant's arguments with respect to claims 1-46 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

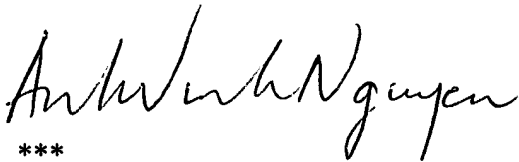
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 703 305-4860. The examiner can normally be reached on 8:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9314 for regular communications and 703 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.



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November 7, 2002

Madeleine AV Nguyen  
Primary Examiner  
Art Unit 2622